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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,854	03/21/2002	Andrew Austen Mortlock	Z70601-1	6749

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,854

Applicant(s)

MORTLOCK ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: .

## DETAILED ACTION

Claims 1-15 are pending.

### *Specification*

1. **Abstract:** This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The disclosure is objected to because of the following informalities: there are unmatched parentheses throughout the specification. For example, the following places are noted for unmatched parentheses:

- a. Page 4, line 23;
- b. Page 7, lines 3 and 10;
- c. Page 13, line 15 (after 'R<sup>14</sup>X<sup>1</sup>-'), and line 22;
- d. Page 14, line 15;
- e. Page 16, line 22;
- f. Page 18, line 17;
- g. Page 21, line 15;
- h. Page 25, lines 9 and 21.

Also on page 9, line 5, there are two commas after R<sup>b</sup>. Thus, it appears as if something is missing between R<sup>b</sup> and R<sup>c</sup>.

Appropriate correction is required. Applicant is advised to check the specification for other misspelled words, and unmatched parentheses.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Use Claims:** Claims 1-10 provide for the use of “a compound of formula (I)”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Also, claims 1-10 have minor informalities such as misspelled words (e.g., “substituted” of claim 1, and “heterocyclyl” of claim 2), unmatched parentheses in the following places:

- Claim 1: Page 75, line 22;
- Claim 4: Page 77, line 9; page 78, lines 1, 6, 11, and 16;
- Claim 6: Page 80, line 30; page 81, line 5;
- Claim 8: Page 84, lines 13 and 20; page 86, line 11;
- Claim 10: Page 88, lines 7, 14, and 27.

4. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. In claim 11, it is not clear if the proviso for  $R^{66}$  and  $R^{67}$  of formula IIB are applicable for the corresponding variables of formulae IIIB, IVB, IVC.
- b. Claim 11 recites variable  $R^{5''}$  which does not bear a relationship to formula IVB. Also, the word 'substituted' is misspelled as "**substituted**" on page 90, line 15.
- c. Claim 12 recites the limitation of "...converting a group  $R^1$ ,  $R^2$ ,  $R^3$  or  $R^4$  to a group  $R^1$ ,  $R^2$ ,  $R^3$ , and  $R^4$  respectively or to a different such group" which is unclear as to what functional group is converted into what. Also, the phrase "a different such group" does not have definite metes and bounds because it is unclear as to what functional groups are included in said phrase.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by the following references:

- a. **Hudson et. al.** (WO 96/09294): For example, see compounds on lines 21, 22 of page 13, and the compound on lines 1, and 12 of page 15. Also, Examples 72, 73, and 174.
- b. **Brown et. al.** (WO 96/15118): For example, see the compound on line 9 of page 30.

The above disclosed compounds read on formula IIB, and the process of making thereof, when formula IIB has the following substituents:

- i.  $R^{66}$  and  $R^{67}$  are both ethoxy – note the proviso is not applicable to both of  $R^{66}$  and  $R^{67}$  as ethoxy;
- ii. Or, one of  $R^{66}$  and  $R^{67}$  is methoxy, and the other is a substituted alkoxy (i.e., “3-morpholinopropoxy”);
- iii. Z is O,  $n = 0$  or 1;
- iv.  $R^9$  is hydrocarbyl or heterocyclyl (i.e., phenyl or pyridyl).

In Examples 72, 73, and 174, Hudson et. al. teach the process of making which reads on a process recited in claim 12, particularly the one having  $R^a$  as  $-(\text{Phenyl}(R^6R^7))-Z-(CH_2)_n-R^9$ . The disclosed compounds are protein or receptor tyrosine kinase inhibitors, and thus, can be incorporated in a pharmaceutical composition for therapeutic use (see page 42 of WO'118).

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*Claim Objections*

6. Claims 11 and 12 are also objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

7. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9 am - 5:30 pm) starting from January 12<sup>th</sup>, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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January 29, 2004



Richard L. Raymond  
Patent Examiner